

**Remarks**

In the Office Action dated September 22, 2005, the Examiner: (i) objected to the claims and specification; (ii) rejected claims 2 and 14 as failing to comply with the enablement requirement; (iii) rejected claims 1, 12, 13, and 20 under 35 U.S.C. 102(b); and (iv) rejected claims 3-11, 15-18 under 35 U.S.C. 103(a). Applicant notes that claims 2 and 14 were not specifically analyzed with respect to sections 102 or 103.

In response, Applicant has canceled claims 3 and 16 and amended claims 1, 4, 8-9, 11, 13, and 20. Claims 1-2, 4-15, and 17-20 will be pending after entry of this Amendment.

**I. Rejections under 102(b)**

The Examiner rejected claims 1, 12, 13, and 20 under 35 U.S.C. 102(b) as anticipated by U.S. Patent 5,631,983 to Graf et al ("Graf"). Applicant respectfully traverses.

**A. Claim 1**

Graf is directed at a system for segmenting and compressing electronic images of documents, particularly checks. Although Graf claims that this system can be used "in a wide variety of other document-related applications," the system is fundamentally directed at the problem faced by banks, namely, to quickly capture large numbers of unrelated documents.

The present invention, in contrast, is directed at a fundamentally different problem. As explained in the background section of the present application, teams of employees frequently need to cooperatively prepare and review documents in the modern workplace. Inevitably, these group projects require that documents be copied multiple times for distribution, for review and re-review, and to create a record of changes. Unfortunately, this process spreads the editorial comments across the multiple copies of the document. Thus, to find all of the changes and/or to retain a record of who made what changes, someone must sort through multiple copies of the document, then extract those pages with comments, then feed those pages into the copier and/or

enter the changes into a computer, then re-insert the pages back into the originals. This process is time consuming and, invariably, results in some lost comments. Moreover, as documents are serially reviewed, it becomes difficult to identify and focus upon new comments.

The present invention solves these problems by providing a way to collate documents with changes, index changes as part of copy job, create side markings as part of a copy job, and/or compare reviewer comments and handwritten additions in the copier job compared to archived documents. In addition, the present invention allows reviewers to work with plain paper and with conventional writing instruments, such as a pencil or ballpoint pen.

With these fundamental differences in mind, Applicant respectfully submits that Graf fails to teach or suggest "detecting *whether* the first image contains a handwritten notation." Unlike the present invention, Graf is not directed at detecting whether or not a check has a signature. It simply assumes that there notations on each check and copies each document. The present invention contemplates that many or even most pages will not have annotations.

To further clarify this distinction, Applicants have also amended claim 1 to include the limitation in claim 3. Graf fails to teach or suggest "printing the first image only if the first image contains at least one handwritten notation." Instead, Graf stores every check for later recall.

**B. Claims 12, 13, and 20**

Claim 12 is dependent on claim 1, and claims 13 and 20 contain limitations similar to those found in claim 1. Accordingly, for the reasons detailed above, Applicant also respectfully traverses Examiner's rejections of claims 12, 13 and 20.

## **II. Rejections under 103(a)**

### **A. References U and V are not dated.**

Applicant is unable to locate any publication date for references U and V, either on the supplied copies or on the supplied form PTO-892. Accordingly, Applicant respectfully requests that the Examiner provide evidence that these documents qualify as prior art. Applicants also reserve the right to submit an Affidavit of Prior Invention after a publication date has been established.

### **B. Even if References U and V were prior art, the proposed combinations do not obviate the claimed inventions.**

A combination of references can only obviate a claim if that combination teaches or suggests all of the claimed limitations. As previously discussed, Graf fails to teach or suggest both "detecting whether the first image contains a handwritten notation" and "printing the first image only if the first image contains at least one handwritten notation."

References U and V also fail to teach or suggest these elements. Instead, References U and V simply teach that Microsoft Word 2002 had a feature where you could track changes in an electronic document. There is no teaching of tracking changes to physical documents, much less detecting whether the first image contains a handwritten notation" or "printing the first image only if the first image contains at least one handwritten notation."

Reference W also fails to teach or suggest these elements. Instead, Reference W (as best understood, the supplied copy is missing a portion of each line) simply teaches that you can detect motion by comparing frames. There is no teaching or suggestion of detecting handwritten notations, much less "much less detecting whether the first image contains a handwritten notation" or "printing the first image only if the first image contains at least one handwritten notation."

Accordingly, Applicant respectfully submits that the proposed combinations do not obviate the inventions in claims 3-11, 15-18.

### **III. Objection to Claims 2 and 14**

The Examiner rejected claims 2 and 14 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner states that:

The disclosure does not state how several key issues are overcome by the proposed invention. First, modern OCR algorithms are capable of recognizing a wide array of handwriting, particularly if the author block printed or is fairly neat. Secondly, figures and images are generally unrecognizable to OCR algorithms, in which case these image elements would be misidentified as handwritten notations.

*Office Action dated September 22, 2005 at paragraph 4.* Applicants respectfully traverse. The focus of the present invention is on the application of various image processing techniques, such as OCR, to solve a specific problem. However, Applicant notes that it did incorporate two references on page 8, lines 21-25 that provide additional detail about OCR technology. For at least these reasons, Applicant believes the above-identified application satisfies the enablement requirement.

### **IV. Miscellaneous Amendments**

Applicant has amended the Specification, claims 8-9, and claim 11 to correct the informalities identified in paragraphs 1-3 of the Office Action dated September 22, 2005.


### **V. Conclusion**

It is believed that the present application is in condition for allowance and a prompt and favorable allowance of all claims is respectfully requested. If the Examiner, upon considering this amendment, thinks that a telephone interview would be helpful in expediting allowance of

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the present application, he/she is respectfully urged to call the Applicant's attorney at the number listed below.

Respectfully submitted,

By:   
Grant A. Johnson  
Registration No.: 42,696

Telephone: (507) 253-4660  
Fax No.: (507) 253-2382

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